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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,644	09/18/2001	Eric Silverberg	1893	1184
7590 Cynthia L. Foulke NATIONAL STARCH AND CHEMICAL COMPANY 10 Finderne Avenue Bridgewater, NJ 08807-0500			EXAMINER GHALL, ISIS A D	
			ART UNIT 1611	PAPER NUMBER
			MAIL DATE 07/03/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/955,644

Applicant(s)

SILVERBERG ET AL.

Examiner

Isis A. Ghali

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 and 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-640)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The receipt is acknowledged of applicants' amendment filed 03/20/2008.

Claims 1-22 previously presented.

Claims 2 and 8 have been canceled.

Claims 1, 3-7, 9-22 are pending and included in the prosecution.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,491,070 ('070).

The present claim is interpreted as require polymer prepared from monomer selected from the group consisting of monomers selected from the group consisting of: alkyl acrylate, alkyl methacrylate monomer and polymerizable non-cyclic nitrogen-containing monomer. Further the claims require 50-98% alkyl acrylate monomers and/or alkyl methacrylate monomers. The claims require therapeutic agent.

US '070 disclosed excellent pressure sensitive adhesive with good tack obtained by the combination of monomers to form polymers consisting of 80-96% of 2-ethylhexyl acrylate and 2.0-19% of octyl acrylamide to create a polymer combination that is synergistic in nature (col.1, lines 52-60). The Tg as claimed by claim 4 is inherent for specific polymer. The pressure sensitive adhesive further comprises ammonium persulfate that is known as antimicrobial agent as evident by US 5,827,505, which reads on therapeutic agent.

Response to Arguments

3. Applicant's arguments filed 03/20/2008 have been fully considered but they are not persuasive. Applicants traverse this rejection by arguing that US '070 must contain only 2-ethylhexyl acrylate, N-octyl acrylamide and methacrylamide, and requires all three. Applicants' polymer is prepared from alkyl acrylate monomer and alkyl methacrylate monomers having up to about 18 carbon atoms in the alkyl group, N-substituted acrylamide monomers, N-substituted methacrylamide monomers, vinylacetamides, and nitriles, and must contain 50 to about 98% of the alkyl acrylate and/or alkyl methacrylate monomers and from about 2 to about 50% of the recited nitrogen-containing monomers. No other monomers are included. Applicants "comprising" language refers to the adhesive composition, not to the acrylic polymer,

which is recited as being prepared from monomers "selected from the group consisting of" only those specifically recited monomers.

In response to these arguments, applicants' attention is drawn to the amended claims that recite: "wherein said polymerizable non-cyclic nitrogen-containing monomers are selected from the group consisting of N-substituted acrylamide monomers, N-substituted methacrylamide monomers, vinylacetamides, nitriles, and mixtures thereof". Methylacrylamide monomer is further claimed by claim 6. Therefore, N-substituted methacrylamide or its mixture with N-octyl acrylamide are within the scope of the present claims as permitted by reciting "mixture thereof", and not only by the "comprising" language of the claims that does not exclude other elements or materials even in major amounts including other polymerizable monomers in the adhesive composition., see *Cues Inc. vs. Polymer Industries*, USPQ 2d 1847 (DC ND GA 1988); *Moleculon Research Corporation v CBS, Inc.* 229 USPQ 805, *In re Baxter* 210 USPQ 795, 803. Therefore, methylacrylamide monomer disclosed by the reference is within the scope of the present claims as an essential element that is a nitrogen-containing monomer.

Applicants further argue US '070 fails to disclose an adhesive comprising a therapeutic agent. While US '505 teaches that ammonium persulfate is a known microbial agent, this patent describes ammonium persulfate as a bleaching agent. While applicants concede that a bleaching agent may be considered as a therapeutic agent, Applicants disagree with the examiner's position that US '070 teaches an adhesive

containing a therapeutic agent. In Example 1 of the US '070 patent, ammonium persulfate is used as an oxidizing agent/catalyst in an amount of 0.18 parts and would be completely consumed in the polymerization.

In response to this argument, it is noticed that the claims included in this rejection are not directed to any specific therapeutic agent. US '070 disclosed that the pressure sensitive adhesive comprises ammonium persulfate that is known as therapeutic agent as evident by US '505. The present invention is directed to composition, and all the elements of the composition are disclosed by US '070, and the future intended use of specific ingredients, such as ammonium persulfate used as oxidizing agent, does not impart patentability to the claims.

4. Claims 1, 3-6, 9-14 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 531 938 ('938).

The present claim is interpreted as require polymer prepared from monomer selected from the group consisting of monomers selected from the group consisting of: alkyl acrylate, alkyl methacrylate monomer and polymerizable non-cyclic nitrogen-containing monomer. Further the claims require 50-98% alkyl acrylate monomers and/or alkyl methacrylate monomers. The claims require therapeutic agent.

EP '938 disclosed medical preparation for percutaneous absorption of drugs (abstract). The preparation is applied on a substrate, i.e. backing (page 3, lines 14-20). The preparation comprises pressure sensitive acrylic based layer obtained by polymerizing 60-98% by weight of alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and from 2-40% by weight of monomer copolymerizable with the alkyl (meth)acrylate (page 4, lines 13-19). The alkyl (meth)acrylate is ethylhexyl

acrylate (page 4, lines 21-22; example 1). The monomer copolymerizable with the alkyl (meth)acrylate includes (meth)acrylamide, meeting claim 6, and (meth)acrylonitrile, meeting claim 3 (page 4, lines 29, 36). The drugs included in the adhesive layer include analgesics, hypnotics and sedatives (page 6, lines 15-21). The Tg as claimed by claim 4 is inherent for specific polymer.

Response to Arguments

5. Applicant's arguments filed 03/20/2008 have been fully considered but they are not persuasive. Applicants argue that the examiner picked and chose isolated passages of EP '938 because applicants' polymer lacks functional groups containing reactive moieties and contains no post polymerization chemical crosslinker. EP'938 fails to disclose an adhesive comprising applicant's required polymer and fails to disclose such an adhesive that also comprises a therapeutic agent as required in the practice of applicants' invention.

In response to this argument, it is argued that EP '938 disclosed clearly polymer obtained by polymerizing 60-98% by weight of alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and from 2-40% by weight of monomer copolymerizable with the alkyl (meth)acrylate. The alkyl (meth)acrylate is ethylhexyl acrylate. The monomer copolymerizable with the alkyl (meth)acrylate includes (meth)acrylamide and (meth)acrylonitrile. Further, the reference disclosed therapeutic agents included in the adhesive layer include analgesics, hypnotics and sedatives. Therefore the rejected claims are anticipated by EP '938. The disclosed examples and

preferred embodiment do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Regarding the crosslinker, applicants' attention is directed to the present disclosure in page 5, lines 10-13, wherein applicants disclosed that: "No post-polymerization chemical cross-linking means that while monomers having multiple polymerization sites may be use to prepare the adhesive of the invention, following polymerization no reactive sites are present in the polymer." In view of applicants' definition to "no post polymerization crosslinker", and since the reference disclosed the same percentage of the monomers as instantly claimed, it is implied that all the reactive sites are reacted and no free reactive sites are present after polymerization, i.e. no crosslinker are present following polymerization.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 7 are rejected under 35 U.S.C. 103(a) as being obvious over '938 in view of US '070.

The teachings of EP '938 and US '070 are discussed under 102 rejections as set forth in this office action.

Although EP '938 teaches methacrylamide, however, the reference does not explicitly teach octyl acrylamide claimed in claims 7, which is taught by US '070 to have a good tack when combined with 2-ethylhexyl acrylate to create a polymer combination that is synergistic in nature.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide pressure sensitive acrylic based adhesive obtained by polymerizing alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and methacrylamide monomer as disclosed by EP '938, and replace the acrylamide monomer with octyl acrylamide disclosed by US '070, motivated by the teaching of US '070 that the combination of alkyl (meth)acrylate and octyl acrylamide has a good tack and creates a polymer combination that is synergistic in nature, with reasonable expectation of having polymer adhesive composition obtained by

polymerizing alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and octyl acrylamide that has good tack and synergistic adhesive nature.

Response to Arguments

9. Applicant's arguments filed 03/20/2008 have been fully considered but they are not persuasive. Applicants argue that the claimed invention would not have been obvious from the combined disclosures of EP '938 and US '070 and the use of octyl acrylamide in the practice of the EP '938 invention would not have resulted in an adhesive comprising a acrylic polymer that lacks functional groups containing reactive hydrogen moieties and contains no post polymerization chemical crosslinker.

In response to this argument, it is argued that EP '938 disclosed clearly polymer obtained by polymerizing 60-98% by weight of alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and from 2-40% by weight of monomer copolymerizable with the alkyl (meth)acrylate. The alkyl (meth)acrylate is ethylhexyl acrylate. The monomer copolymerizable with the alkyl (meth)acrylate includes (meth)acrylimide and (meth)acrylonitrile. Further the reference disclosed the same percentage of the monomers as instantly claimed, and this implies that all the reactive sites are reacted and no free reactive sites are present after polymerization, i.e. no crosslinker are present following polymerization, in view of applicants' definition of "no post polymerization cross linker", as set forth in section 5 of this office action. Replacing nitrogen containing monomer by another known to be suitable to perform the same function is within the skill of artisan versed in the art, specially EP '938 teaches butyl-

acrylamide (page 4, line 29). The burden is on applicants to show that substituting acrylamide monomer disclosed by EP '938 with octyl acrylamide disclosed by US '070 would not have resulted in an adhesive comprising a acrylic polymer that lacks functional groups containing reactive hydrogen moieties.

A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a).

10. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '938 in view of US 6,139,866 ('866).

The teachings of EP '938 are discussed under 102 rejections as set forth in this office action.

Although EP '938 teaches analgesics, sedatives and hypnotic drugs to be delivered by the disclosed adhesive, however, the reference does not explicitly teach fentanyl as claimed by claims 15-17.

US '866 teaches suitability of fentanyl to be administered transdermally with little skin irritation and its ability to provide prolonged analgesic or anesthetic effect (abstract; col.1, lines 15-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide pressure sensitive acrylic based adhesive obtained by polymerizing alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and methacrylamide monomer to deliver analgesic, hypnotic or sedative as disclosed by EP '938, and replace the analgesic, sedative or hypnotic drug with fentanyl that is taught by US '866 as being suitable for transdermal administered with little skin irritation and prolonged analgesic or anesthetic effect, with reasonable expectation of having fentanyl successfully delivered from polymer adhesive composition obtained by polymerizing alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and methacrylamide without skin irritation and with prolonged analgesic or anesthetic effect.

Response to Arguments

11. Applicant's arguments filed 03/20/2008 have been fully considered but they are not persuasive. Applicants hereby repeat the argument regarding EP '938 as in section 9 of this office action, and further argue that the use of fentanyl invention would not have resulted in an adhesive comprising an acrylic polymer that lacks functional groups containing reactive hydrogen moieties and contains no post polymerization chemical crosslinker.

In response to this argument, the examiner response in section 9 is repeated. The examiner further argue that the burden is on applicants to show that substituting analgesics and sedatives disclosed by EP '938 with fentanyl disclosed by US '866

would not have resulted in an adhesive comprising an acrylic polymer that lacks functional groups containing reactive hydrogen moieties.

A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a).

12. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '938 in view of US 5,458,885 ('885).

The teachings of EP '938 are discussed under 102 rejections as set forth in this office action.

Although EP '938 teaches two or more alkyl (meth)acrylate in the polymer, however, the reference does not explicitly teach 2-ethylhexyl acrylate and methyl acrylate as required by claims 18 and 20.

US '885 teaches transdermal system comprising polymer made of methyl acrylate and 2-ethylhexyl acrylate wherein the polymer is suitable to deliver basic active agents and their salts including analgesics (col.2, lines 43-55; col.3, lines 3-9, 64-67; col.4, lines 1-50; col.6, lines 37, 50-60; col.7, lines 1-9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide pressure sensitive acrylic based adhesive obtained by polymerizing alkyl(meth)acrylate monomer having 4 to 15 carbon atoms in the alkyl moiety and methacrylamide monomer as disclosed by EP '938, and replace the acrylate monomer with methyl acrylate and 2-ethylhexyl acrylate as disclosed by US '885, motivated by the teaching of US '885 that such a polymer is suitable to deliver basic active agents and their salts including analgesics, with reasonable expectation of having polymer adhesive composition made of alkyl acrylate monomer made of 2-ethylhexyl acrylate and methyl acrylate and acrylamide monomer wherein the polymer provides successful delivery to basic therapeutic agents including analgesics.

Response to Arguments

13. Applicant's arguments filed 03/20/2008 have been fully considered but they are not persuasive. Applicants argue that the claimed invention would not have been obvious from the combined disclosures of EP '938 and US '885. There is no suggestion to use only those monomers that would result in an acrylate polymer that lacks functional groups containing reactive hydrogen moieties and contains no post polymerization chemical crosslinker and such an adhesive would be contrary to the teachings of EP '938,

In response to this argument, it is argued that US '885 is relied upon for the solely teaching of methyl acrylate and 2-ethylhexyl acrylate as suitable monomer to deliver basic active agents and their salts including analgesics. This teaching would

have motivated one having ordinary skill in the art to replace the acrylate monomer disclosed by EP '938 with methyl acrylate and 2-ethylhexyl acrylate disclosed by US '885 with reasonable expectation of having polymer adhesive composition made of alkyl acrylate monomer made of 2-ethylhexyl acrylate and methyl acrylate and acrylamide monomer wherein the polymer provides successful delivery to basic therapeutic agents including analgesics. It has been held that "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int 'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraid v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a).

14. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '938 in view of US '885 and further in view of US '070.

The combined teaching of EP '938 and US '885 are discussed as set forth in this office action.

However, the combined teaching of the EP '938 and US '885 does not teach octyl-acrylamide that is taught by US '070 to have a good tack when combined with 2-ethylhexyl acrylate to create a polymer combination that is synergistic in nature.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide polymer adhesive composition made of alkyl acrylate monomer made of 2-ethylhexyl acrylate and methyl acrylate and acrylamide monomer as taught by the combined teaching of EP '938 and US '885, and replace the acrylamide with octyl acrylamide as taught by US '070, motivated by the teaching of US '070 that the combination of alkyl acrylate and octyl acrylamide has a good tack and creates a polymer combination that is synergistic in nature, with reasonable expectation of having polymer adhesive composition made of alkyl acrylate monomer comprising 2-ethylhexyl acrylate and methyl acrylate, and octyl acrylamide monomer that has good tack and synergistic adhesive nature.

Response to Arguments

15. Applicant's arguments filed 03/20/2008 have been fully considered but they are not persuasive. Applicants argue that the claimed invention would not have been obvious from the combined disclosures of EP '938 and US '885, further in view of US '040 because there is no suggestion to use only those monomers that would result in an acrylate polymer that lacks functional groups containing reactive hydrogen moieties and

contains no post polymerization chemical crosslinker and such an adhesive would be contrary to the teachings of EP '938.

In response to this argument, it has been held that in considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). Further, it has been held that "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int 'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute

predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a).

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-

0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Isis A Ghali/
Primary Examiner, Art Unit 1611

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